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Applicant : Brian A. Urbach
Serial No. : 10/047,534
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For : BALL JOINT WITH DUAL
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Attorney Docket No. : TRW(M)5857

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REPLY BRIEF

Sir:

This Reply Brief is in response to the Examiner's Answer dated March 22, 2006. This Reply Brief addresses the grounds of rejection set forth in section 9 of The Examiner's Answer and the response to arguments in section 10 of the Examiner's Answer.

1. **The Written Description Rejection of claims 1-12.**

In the Appeal Brief of December 27, 2005 ("Appeal Brief"), Applicant argued that the present Application meets the written description requirements of 35 U.S.C. §112, first paragraph because Figs. 1 and 2 of the present Application fully support the currently pending claims.

In the Examiner's Answer, the Examiner submits the following contentions to Applicant's arguments regarding 35 U.S.C. §112, first paragraph: (a) that the Specification does not mention "imaginary lines." (b) the Specification is silent on the drawings being to scale. (c) when a reference does not disclose that drawings are to scale, that the drawings in the reference cannot be relied on to show particular sizes. and (d) the engineering drawing submitted as evidence that Figs. 1 and 2 are drawn to scale is not part of the original specification and cannot be relied on. Applicant respectfully disagrees with the Examiner's contentions.

As stated above, the Examiner contends that the Specification of the present Application does not mention "imaginary lines." Drawings alone may provide a written description of an invention. Vas-Cath, Inc. v. Mahukar, 935 F.2d 1555, 1565, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991). In the present application, one skilled in the art would fully understand the phrase "imaginary lines" when the application is viewed at Figs. 1 and 2. Accordingly the claims are fully supported by the disclosure of the present application.

As stated above, the Examiner also contends that when a reference does not disclose that drawings are to scale, that the drawings in the reference cannot be relied on to show particular sizes. To support this contention, the Examiner cites Hockerson-Halberstadt, Inc. Avia Group Int'l, 22 F.3d 951, 956, 55 U.S.P.Q. 1487,

1491 (Fed. Cir. 2000). However, in Hockerson-Halberstadt, the Federal Circuit was considering an infringement claim based on a drawing, wherein the prosecution history and the drawings of a patent application were in conflict. 22 F.3d 951, 956, 55 U.S.P.Q. 1487, 1491 (Fed. Cir. 2000). The court did not consider the scale of the drawings for purposes of considering the claims under 35 U.S.C. §112, first paragraph.

Furthermore, the Examiner contends that the engineering drawing submitted as evidence that Figs. 1 and 2 are drawn to scale is not part of the original specification and cannot be relied on. It is respectfully submitted that the engineering drawing was submitted simply as evidence that Figs. 1 and 2 were prepared using a scaled drawing as a reference.

2. The Obviousness Rejection of claim 1.

Claim 1 recites a second suspension member having a through-hole with first and second frustoconical surfaces. In the Examiner's Answer, the Examiner contends that Greubel et al. provides a link between using a frustoconical surface instead of a spherical surface as taught by Stroh (See Examiner's Answer Page 15). However, Greubel et al. does not teach or suggest the first and second frustoconical surfaces recited in claim 1.

Additionally, the Examiner contends that Sommerer is being used to provide motivation for implementing frustoconical surfaces in the apparatus disclosed in Stroh instead of using a spherical surface disclosed in Stroh (See Examiner's Answer, Page 15). In Sommerer, the necks 11 and 12 do not teach or suggest a through-hole with first and second frustoconical surfaces, as recited in claim 1.

Additionally, there is no evidence of record that spherical and frustoconical surfaces are interchangeable, as suggested by the Examiner.

Furthermore, it is respectfully submitted that the Examiner is impermissibly using Applicant's Appeal Brief as the motivation to combine Stroh and Sommerer. The Examiner impermissibly cites portions of Applicant's Appeal Brief filed December 27, 2005 as disclosing the advantages of frustoconical surfaces over spherical surfaces (See Examiner's Answer, Page 15). Accordingly, taken individually or in combination, Stroh, Sommerer and Greubel et al. do not teach or suggest a second suspension member having a through-hole with first and second frustoconical surfaces, as recited in claim 1.

Claim 1 also recites a one-piece stud having a second end portion with a third frustoconical surface. The Examiner contends that it would have been obvious to modify the combination of Stroh, Sommerer and Greubel et al. to include frustoconical surfaces because the surfaces are superior over spherical surfaces. However, once again, the Examiner is impermissibly using the statements made by Applicant as the motivation to combine and modify the teachings of Stroh, Sommerer and Greubel et al.


Furthermore, there is no teaching or suggestion in the references to modify the embodiment of Fig. 3 of Stroh to include frustoconical surfaces as contended by the Examiner (See Examiner's Answer, Page 16). It is respectfully submitted that one of ordinary skill in the art will not recognize spherical and frustoconical surfaces as being equivalents. The Examiner contends that since Applicant consents that frustoconical surfaces would be superior to spherical surfaces, that it would be obvious to use frustoconical surfaces (See Examiner's Answer, Page 16).

Serial No. 10/047,534

Accordingly, it is respectfully submitted that the Examiner is impermissibly using the statements made by Applicant as the motivation to combine and modify the teachings of Stroh, Sommerer and Greubel et al.

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Respectfully submitted,


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